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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,096

01/24/2005

Thomas Ehrhardt

BASF. 10027

9245

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EXAMINER

SAIDHA, TEKCHAND

ART UNIT

PAPER NUMBER

1652

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

02/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/522,096

Applicant(s)

EHRHARDT ET AL.

Examiner

Tekchand Saidha

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7, 9-15, 17-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-7, 9-15, 17-20 & 22-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Preliminary amendment filed January 24 2005 is acknowledged. Claims 2-7, 9-15, 17-20 & 22-25 are pending in this application, which claims are subject to the following restriction requirement.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.
3. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
4. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 2 & 5-7, drawn to plant nucleic acid [SEQ ID NO: 1 or 3 (*Nicotiana tabacum*) or SEQ ID NO: 5 (*Solanum tuberosum*)] encoding sucrose-6-phosphate phosphatase.

Group II, claim(s) 3, drawn to a polypeptide having the biological activity of sucrose-6-phosphate phosphatase.

Group III, claim(s) 4, drawn to a method of detecting functional analogs of SEQ ID NO: 1 or 3 or 5.

Group IV, claim(s) 9-13, 15, 17 & 20, drawn to a method of identifying herbicidally active substances using the polypeptide of SEQ ID NO: 2 or 4 or 6 (or the encoding nucleic acid sequence of SEQ ID NO: 1 or 3 or 5) and compound identified.

Group V, claim(s) 14 & 18, drawn to method for identifying substances with a growth-regulatory action and the compound identified.

Group VI, claim(s) 19, drawn to a process of preparing an agrochemical composition comprising identifying the

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herbicidally active compound by the method of group of IV and formulating herbicidally active compound.

Group VII, claim(s) 22 & 23, drawn to a method for generating nucleic acid sequences which encode a polypeptide with the biological activity of sucrose-6-phosphate phosphatase.

Group VIII, claim(s) 24-25, drawn to a method of generating transgenic plant resistant to substances identified by the method of claim 17.

5. For each of inventions I-VIII above, restriction to one of the following (A-F) is also required. Therefore, election is required of one of inventions I-VIII and one of the sequences **as applicable** to the elected group:

(A). SEQ ID No: 1.

(B). SEQ ID No: 2.

(C). SEQ ID No: 3.

(D). SEQ ID No: 4.

(E). SEQ ID No: 5.

(F). SEQ ID No: 6.

6. The inventions listed as Groups I-VIII and (A)-(F) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: The technical feature linking Groups I-VIII and (A)-(F) appears to be that they all relate to sucrose-6-phosphate phosphatase and the encoding DNA. According to the international preliminary examination report [IPER] submitted by the Applicants, Lunn et al. ['Purification, molecular cloning, and sequence analysis of sucrose-6F-phosphate phosphatase from plants', PNAS, Vol. 97, No. 23, (7 November 2000), pages 12914-9], teach cloning of sucrose-

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6F-phosphate phosphatases from various plants (page 12915, figure 2, table3) and their expression in *Escherichia coli*. The disclosed sequence AF283565 of *Arabidopsis thaliana* is approximately 70% identical to the claimed nucleotide sequences and 80% identical to the amino acid sequences and therefore anticipate claims 2 & 3, for example, for lacking novelty.

Therefore, Groups I-VIII share no special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Furthermore, the products of Groups I-VIII and (A)-(F) do not share a special common structural or functional feature while, the methods of Groups III-VIII do not use the same reagents or produce the same results. In addition, the methods of Groups III-VIII do not comprise all of the methods for making or using the products of Groups I-II. Accordingly, Groups I-VIII and (A)-(F) are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

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Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha whose telephone number is (571) 272 0940. The examiner can normally be reached on 8.30 am - 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272 0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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February 17, 2005